The amendments do not broaden the scope of the Specification and do not constitute new matter. They are meant merely to illustrate matter already existing in the Specification, in order to aid the Examiner's review of the application.

II. AMENDMENT TO CLAIMS:

These proposed claim amendments withdraw many of the claims and place further limitations in others, in response to recommendations by the Examiner. Further minor clarifications have been made. All have antecedent basis in the original Specification and are not an attempt to broaden the scope of the claims.

Where limitations were added to the claims, they are limitations not present in the prior art cited by the Examiner in the First Office Action, but are found in the present disclosure. Further, there are no suggestions or motivations in the teachings of the prior art that are relevant to the present disclosure's limitations.

Although specific examples of antecedent basis are provided, should the Examiner require more examples in the future, the Applicant asks for the right to provide such further examples in reply.

For the sake of avoiding undue repetition throughout this document, the Applicant does not repeat all examples in each subsequent section and instead incorporates by reference relevant examples in subsequent sections which deal with similar subject matter.

A.) Claims 1-12:

1.) "computer-based" system:

Claims 1 (and Claims 2 through 12, its dependent claims) were amended to include the limitation that the system at issue was designed to run on a computer or multiple linked

computers. The antecedent basis lies in Fig. 1, as well as Specification paragraphs 0056-060 (page 4). Moreover, numerous references are made to the "Control Computer" (label 16 in the figures), and paragraph 0061 makes it clear that this physical item is later referred to, functionally, as part of the "Data Manager" (labeled 20 in the figures). Thus, there are ample references to the physical embodiment of the disclosure in a computer.

A computer is a machine, and "a machine is proper statutory subject matter under sec. 101." *State Street Bank & Trust Co. v. Signature Financial Group, Inc.,* 149 F.3d. 1368, (Fed. Cir. 1998), cert. den., 525 U.S. 1093 (1999).

This is meant to adopt a suggestion by the Examiner, that the claims delineate a "real world value." Making it clear that the present disclosure is embodied and operative in a machine, as pointed out in the original Specification, illustrates real world value and makes the claims tangible and concrete.

2.) contact information "consisting of a plurality of different type of contact information":

Claim 1 was further amended to include the limitation that the data in the database consists not just of contact data for a plurality of different entities, but that the contact information is of more than one type. That is, *the database* should contain more than a single type of contact information in order to function.

Thus, for example, the database doesn't consist merely of Email addresses, but must also have data such as a postal address or another type of contact information. This is stated in paragraph 078 (et seq.) of the Specification. This is discussed in several places in the Specification, including paragraphs 0078, 0031, and throughout the tables.

This limitation is not present in the prior art cited by the Examiner.

3.) "returning" a response to "the query originator":

Claim 1 was further amended to clarify that the data is returned by the system to the party that made the query in the first instance.

The return of the data is contemplated throughout the Specification and discussed in multiple places in the Specification, including paragraphs 0073, 0022, 0116, 0080, 0097, 0132, 0193, and elsewhere. The query originator is discussed very early in the Specification, in paragraph 0006; it can be a "Sender—a person, institution, or business desiring communication with the Recipient" or, of course, a computer program that the Sender puts in action. See, e.g., Figures 1 and 2 and paragraphs 0060 and 0066, illustrating how a query might come into the system remotely, electronically. Moreover, paragraph 0064 points out that the Sender's communication with the system is "non-interventional," that is, done by software—the Sender's proxy—rather than a person. Paragraph 0024 also discusses this automation vis-à-vis the Sender and system.

And "Recipient" is defined in paragraph 0004 as "a person, household, institution or business" and "has the same meaning as 'entity' which is used in the claims."

Later, the Specification specifically states, in paragraph 0073, that "records that are found are returned …for outputting to the Sender, typically in the form of a character string to be displayed as a printed response, as an update to the Sender's database, or as an electronic output file." Put another way, as a concrete example, in paragraph 0085 (and again in paragraph 0090): "new Email addresses will then be returned to the querying Sender." See also, paragraph 0021, and see 0022: "a means for returning this related, alternate [personally identifiable information] which is of the same type as that provided in the query." Further, see paragraph 0027: "that Email address or addresses found in the further searching is returned in response to the query, as an alternative to the original query."

This return of information to the original querying party is also specified in alternative embodiments, such as in paragraph 0112: "to return all the Email addresses linked to that Recipient that are different than the Email address in the initial query." See also, paragraph 0132.

This limitation is meant to adopt a suggestion by the Examiner, that the claims delineate a "real world value," in that it is a "useful, concrete, and tangible" output from the system, as noted throughout the Specification. The return of data in printed form, a character string, electronic data file, or otherwise, to the originator of a query is supported by the above specific recitations in the Specification. The return of data is a useful and concrete result.

4.) "data in a computer or human readable, computer storable, and computer transmittable format":

Claim 1 was further amended to include the limitation that the data which is returned by the computer system is computer data, which is readable, storable, and transmittable. This data is returned to the requestor (originator of the query, i.e., Sender). The antecedent basis appears in multiple places in the Specification, including Fig. 1, paragraphs 0054-55 (page 4), paragraph 0073 (page 5), paragraph 0127 (p. 9), and other locations.

As noted above, paragraph 0073 points out that records found "are returned …for outputting to the Sender, typically in the form of a character string to be displayed *as a printed response*, as an update to the Sender's database, *or as an electronic output file*. (emphasis added.)

A "printed response" is a hard-copy paper form, or a video screen visualization, that can be read by a human, and is thus an "output or display to the user" (as noted by the Examiner) and is, as such, useful, concrete, and tangible.

Data or information which is stored, used, or managed in computer hardware memory is statutory subject matter. *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

This is meant to adopt a suggestion by the Examiner, that the claims delineate a "real world value." Data outputted at the end of a process, in a computer or human readable form is "useful, concrete, and tangible result."

5.) additional changes:

Claim 1 was further amended to make a few minor word-order changes for the sake of clarity in reading. These were meant to help put the claims in condition for allowance and do not broaden the claims. They are meant to assist the Examiner.

B.) Claims 6 (and 18, 19, and 24):

1.) "and said second type is a name and postal address":

Claim 6 (a dependent claim arising from Claim 2, which, in turn, is dependent upon Claim 1), as well as Claims 18,19, and 24, were amended to include the limitation that the second type of information (as seen in Claim 2, sub line b, and Claim 13, sub line d, and Claim 23, sub line d1) is a name and postal address.

The antecedent basis for this exists in the original Specification in multiple places, such as in paragraph 0080: "each record would contain at least two [of] elements of [personally identifiable information], such as an Email address with a related postal address, an Email address with a related name…." This is further discussed the Specification and shown in the tables, such as paragraph 0079: "…a table of unique postal addresses…and [] a third table to show the relationships between the two types of data elements." Paragraph 0081 is even more explicit: "when the initial query contains an Email address, the process preferably appends other types of [personally identifiable

information] (such as a name and postal address related to the query's Email address), which is of a different type from the initial query [personally identifiable information] type, to the query response."

C.) Claims 13-22:

1.) Method for "obtaining alternate contact information for an entity":

Claims 13 (and Claims 14 through 22, its dependent claims) were amended to include the phrase that appears throughout the Specification and even in the Title of the disclosure. This purpose of the disclosure is explained and appears in locations starting with paragraph 0002, and continuing throughout paragraph 0020 and others.

As noted above, "entity" is defined in the Specification, paragraph 0004.

Obtaining alternate contact information is a useful, concrete result.

2.) "entity":

Claims 13 (and Claims 14 through 22, its dependent claims) were amended to include the word "entity" modifying the words "contact information" because the data manipulated by the present disclosure is personally identifiable information used to identify and contact a recipient. As noted above, "entity" is defined in the Specification, paragraph 0004.

3.) "receiving a query consisting of entity contact information of a first type, said query having been originated by a person or computer program":

Claim 13 adds a limitation to the claim, noted throughout the Specification, particularly in paragraph 0006, where the "Sender" is defined, then in paragraph 0075, where the

query contents are discussed, and, moreover, in paragraph 0080-81 wherein the process is described.

Preceding paragraphs in this document give additional examples of the use of this limitation, above, and, at the sake of avoiding undue repetition, shall be deemed incorporated herein.

4.) "data in a computer or human readable, computer storable, and computer transmittable format":

Claim 13 was further amended to include the limitation that the response which is returned by the method is computer data, which is readable, storable, and transmittable. This data is returned to the requestor (originator of the query). The antecedent basis for this appears in multiple places in the Specification, including Fig. 1, paragraphs 0054-55 (page 4), paragraph 0073 (page 5), paragraph 0127 (p. 9), paragraph 0097, et al.

This temporary storage of the information in this format is discussed in paragraphs 0102 et seq., including paragraph 0111.

The return of the data in the response is discussed in multiple places in the Specification, including paragraph 0116. The process to arrive at that return is outlined in paragraph 0080, et seq.

The return of the response to the query is a "useful, concrete, and tangible result." As noted above, data or information which is stored, used, or managed in computer hardware memory is statutory subject matter. *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

5.) Corrections to paragraph numbering errors:

Claims 14 through 22 were erroneously mis-numbered during the prosecution. Each contained an incorrect reference to a preceding claim. Each refer to a prior method claim, but there are no method claims with a number less than 13. As such, the error has an obvious solution: to correct the number of the antecedent claim, as the claims listing shows.

For example, Claim 14 stated that it is "[a] method, as in Claim 9" while Claim 9 was not a method claim. Claim 14 follows immediately after the first method claim, Claim 13, and obviously relates to Claim 13. Moreover, it refers to "searching" "using said second type of contact information" and "said first type" of information, both of which appear in Claim 13, and this verbiage is clearly method-based.

This should not affect the Examiner's prior analysis, since his analysis was primarily based upon a rejection of the independent claims from which these claims depended. The Applicant asks that these numbering changes be accepted. The changes are meant to help put the claims in condition for allowance and do not broaden the claims.

6.) additional changes:

Claim 13 was further amended to make a few minor word-order changes for the sake of clarity. These were meant to help put the claims in condition for allowance and do not broaden the claims.

Claims 18-22 were amended to clarify that the response was meant to be a single item of information for each queried input. Claim 13 refers to "identified alternate contact information" and Claims 18-22 have the limitation that a single item of alternate contact information is returned, rather than multiple items.

This does not broaden the claims and is meant only to have the dependent claims agree in number with the independent claim.

D.) Claims 23-24:

1.) "alternate" "entity" contact information:

Claim 23 (and its dependent claim, Claim 24) was amended to include the limitations that the contact information has to be both "alternate," as in different from the query's contact information, and that it be for an "entity," which is defined within the Specification. This simplifies the wording of the claim preamble.

In order to avoid undue repetition, the preceding paragraphs' references to the antecedent basis of these changes are incorporated herein.

2.) "receiving a query consisting of contact information of a first type, said query having been originated by a person or computer program":

Like Claim 13, Claim 23 adds a limitation to the claim, noted throughout the Specification, particularly in paragraph 0006, where the "Sender" is defined, then in paragraph 0075, where the query contents are discussed, and moreover in paragraph 0080-81 wherein the process is described.

The prior discussion, above, is incorporated herein, to avoid undue repetition.

3.) "by using alternate contact information of a second type and repeatedly searching through said database using said alternate contact information of a second type and alternate contact information of said first type to find all contact information related to said entity":

Claim 23 adds a limitation that is outlined in the Specification, paragraphs 0080-0083, as well as other parts of the Specification, including paragraphs 0091-0095.

4.) "data in a computer or human readable, computer storable, and computer transmittable format":

Like Claim 13, Claim 23 was further amended to include the limitation that the response which is returned by the method is computer data, which is readable, storable, and transmittable. This data is returned to the requestor (originator of the query, i.e., Sender). The antecedent basis for this appears in multiple places in the Specification, including Fig. 1, paragraphs 0054-55 (page 4), paragraph 0073 (page 5), paragraph 0127 (p. 9), paragraph 0097, et al.

This temporary storage of the information in this format is discussed in paragraphs 0102 et seq., including paragraph 0111.

The return of the data in the response is discussed in multiple places in the Specification, including paragraph 0116. The process to arrive at that return is outlined in paragraph 0080, et seq.

The return of the response to the query is a "useful, concrete, and tangible result." As noted above, data or information which is stored, used, or managed in computer hardware memory is statutory subject matter. *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

5.) minor change:

Claim 24 was amended, as explained above in section C.5., merely to correct numbering.

E.) Claims 11, 20-21, 25-36:

Claims 11, 20-21, and 25-36 are amended, but withdrawn from consideration.

III. CONCLUSION

For the reasons stated above, the Applicant asks that the Examiner enter the amendments contained herein, withdraw all rejections with respect to the claims, and allow the application to issue as a patent.

Thank you,
Sincerely,

Ed Skoch